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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIKO MIKAMI

Appeal 2009-006640
Application 10/632,160
Technology Center 2400

Before HOWARD B. BLANKENSHIP, STEPHEN C. SIU, and DEBRA K. STEPHENS, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

STATEMENT OF THE CASE

In papers filed November 29, 2010, Appellant requests a rehearing under 37 C.F.R. § 41.52 from the Opinion of the Board of Patent Appeals

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

and Interferences (hereinafter Board), dated September 28, 2010. In the Opinion, we affirmed the Examiner's rejection of claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gatz and Walker.

Appellants allege that the Board erred by misapprehending or overlooking Appellants' arguments previously raised in the Briefs. (Req. Reh'g. 1-19). In particular, Appellants allege the following errors:

i. The Board overlooked Appellant's arguments pertaining to whether the combination of Gatz and Walker discloses or suggests a request from a first user identifying a list of one or more applications that the first user is permitted to execute and storing the list in the profile of a second user (Req. Reh'g 13-19).

ii. The Board overlooked Appellant's arguments and misconstrued the combination of Gatz and Walker in finding that it would have been obvious to one of ordinary skill in the art to have combined the references (Req. Reh'g 3-12).

We have carefully reviewed the Opinion in light of Appellants' allegations of errors. We will address those remarks in the order as outlined above.

i. We find without merit Appellant's first allegation of error that we overlooked Appellant's arguments pertaining to whether the combination of Gatz and Walker discloses or suggests the disputed claim limitation.

Appellant argues that:

- 1) while Walker and Gatz discloses that a “user is permitted to execute one or more applications, this is not the same as a finding that Walker and/or Gatz teaches ‘a list of one or more applications that the first user is permitted to execute’” and that this list is included within a request from a first user” (Req. Reh’g 15);
- 2) the fact that Gatz discloses that a parent may override restrictions on a child account “does not refer . . . to the claimed list or that the list is included within a request from a first user” (Req. Reh’g 15).
- 3) we assumed “without factual basis, that the claimed ‘list of one or more applications that a first user is permitted to executed’ is needed for a parent to modify a child account” (Req. Reh’g 16);
- 4) “The alleged fact that Gatz and Walker teach that a first user . . . can access a particular application by default does not necessarily require . . . that a list exists for applications that the first user is permitted to execute” (Req. Reh’g 17);
- 5) “There has been . . . no findings of fact, supported by substantial evidence, that the claimed ‘list of one or more applications that the [patent *sic*]/supervisor] is permitted to execute’ is a familiar element” (Req. Reh’g 17);
- 6) “[T]here is no established need for the claimed list” (Req. Reh’g 17); and

7) “[T]here is no technical requirement that access, by a parent, to a particular application is required in order for the parent to restrict access, by a child, to that particular application” (Req. Reh’g 18).

As we stated in the Opinion, we disagree with Appellant’s contentions. We provide further clarification on this issue as follows.

Gatz discloses creating “a ‘family’ account . . . [that] allows the server to track account identifiers . . . for each child in the family” by “a parent that controls the family account (‘the controlling parent’)” (§ [0071], ll. 1-6) who “can control the access and settings of the user of the child account” (§ [0058], ll. 3-5). Hence, in Gatz, a parent creates a family account that includes accounts for both the parent and child, the child account having access to (permitted to execute) certain applications as dictated by the “parent.”

First, we agree with the Examiner that the parent has access to (i.e., permitted to execute) applications that the parent designates as permissible for the child because it would not make sense that the parent would be able to grant access to an application or site that the parent him/herself is not permitted to access or execute. This is particularly true considering that the whole point of the Gatz system is for a parent to monitor and restrict a child’s access to certain applications or sites that the parent deems unacceptable for the child. At the very least, we agree with the Examiner that it would have been obvious to one of ordinary skill in the art, given that a parent controls access of a child to applications by designating which applications are permissible, to ensure that the parent has access to those

designated applications as a matter of common sense. “It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 402 (2007).

However, even assuming Appellant’s assertion to be correct that it would somehow not have been obvious to one of ordinary skill in the art to have permitted access to or execution of applications and sites to a parent in Gatz simply because Gatz supposedly does not explicitly state in so many words that the parent has definitive access or may execute the applications that the parent grants access to the child, Walker also discloses a system in which a parent restricts access to applications and sites for a child (just as in Gatz) that Walker explicitly discloses as including access by the parent “without restriction” (col. 10, l. 16). Thus, Walker confirms by explicitly disclosing what Gatz implies, namely, that in a computer system in which a parent controls a child’s access to applications or sites, the parent has access (that is without restriction) to the applications or sites that the parent grants to the child. We provide the following clarification regarding the Walker reference.

Just as in Gatz, Walker also discloses a system in which a person, such as a parent (col. 10, l. 12), restricts access to (i.e., grants permission to execute) applications to another user, such as a child (col. 10, l. 13). Walker further discloses that the parent accesses or executes applications or sites “without restriction” (col. 10, l. 16) and that the parent “selects acceptable

web sites and adds them to a database of authorized web sites that the child (employee) may visit” (col. 10, ll. 16-18). Hence, in Walker, a parent has unrestricted access (and permission to execute) applications and sites and selects certain “acceptable” applications or sites to be included in a database, the “acceptable” applications or sites being those applications or sites in the “unrestricted group” of applications or sites that are deemed to be accessible to the child (permitted to execute). In other words, the parent provides a list of applications (i.e., “acceptable” applications or sites) to which the parent has access (as demonstrated by the fact that the parent has access “without restriction”).

In both Gatz and Walker, a system is provided in which a parent restricts a child’s access to applications or sites in which it is either implicit (Gatz) or explicit (Walker) that the parent has access him/herself to the applications or sites that the parent grants access to the child. We find this disclosure to be equivalent, or at least suggestive, of the disputed claim feature.

Regarding storing the list in the profile of the second user, Walker also discloses, for example, adding new “authorized” applications and sites to “a selected user profile” based on selections of the parent (col. 12, ll. 1-3). We find no difference in a parent in the Walker system adding designated acceptable applications and sites to a child’s profile and the claimed feature of storing a list of applications in the profile of a second user (e.g., a child).

Appellant also argues that we “overlooked the issues raised by Appellant . . . and deviated from the findings made by the Examiner” (Req.

Reh’g 14) because, according to Appellant, the Examiner relied solely on Gatz rather than the combination of Gatz and Walker (Req. Reh’g 14). We are confused by Appellant’s assertion because the Examiner relies on “the combination of Gatz in view of Walker” (Ans. 11) and not on Gatz alone and rejects claims 1-11 as being unpatentable over Gatz and Walker (App. Br. 4).

Therefore, we disagree with Appellant that we overlooked or misconstrued this issue.

ii. We also find without merit Appellant’s second allegation of error that we overlooked Appellant’s arguments and misconstrued the combination of Gatz and Walker in finding that it would have been obvious to one of ordinary skill in the art to have combined the references. Appellant argues the following:

1) “Appellant did not raise the issue of Gatz and Walker not being within the same field of endeavor” (Req. Reh’g 4);

2) “the Honorable Board has improperly shifted the burden of proof” (Req. Reh’g 5);

3) “[t]here is no requirement that Appellant’s claimed invention produce unpredictable results” (Req. Reh’g 6);

4) “a reliance [on ‘predictable results’] constitutes a new grounds of rejection” (Req. Reh’g 8) that “require different findings of fact . . . [that] have not been articulated by either the Examiner or the Honorable Board” (Req. Reh’g 9); and

5) “the Decision does not indicate whether or not these arguments [pertaining to combinability of Gatz and Walker] were considered” (Req. Reh’g 12).

We provide further clarification on the issue of the combinability of the Gatz and Walker references as follows.

As we stated above and as pointed out by the Examiner, both Gatz and Walker disclose systems that would have been known to those of ordinary skill in the art in which a parent selects applications or sites that the parent deems acceptable for a child to access or execute. The child then has access to the applications or sites that the parent selects. As described above, Walker further discloses certain additional features of the known systems, some of which are implied by Gatz. For example, as described above, Walker explicitly discloses that the parent has unrestricted access to applications and sites and that the “acceptable” applications or sites, after being selected by the parent, are stored in the child’s user profile.

In other words, the combination of Gatz and Walker is the merging of two functionally equivalent systems, both of which would have been known to those of ordinary skill in the art, with no change in the function of either system. This is true because both known systems of parental control of child access to applications or sites would still perform the same functions of controlling a child’s access to applications or sites in the same way whether the systems were combined or not. When “. . . the combination . . . only unites old elements with no change in their respective functions . . . [the combination] obviously withdraws what already is known into the field of its

monopoly and diminishes the resources available to skillful men” (*KSR*, 550 U.S. at 415-416 (citing *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.* 340 U.S. 147, 152-153 (1950))). As such, a combination of such known elements performing their known functions to yield predictable results “is likely to be obvious” (*KSR*, 550 U.S. at 416) – in this case, combining two known systems in which a parent controls a child’s access to applications and sites by selecting the acceptable applications and sites and storing the selected items in a profile of the child to achieve a system that performs this same function.

Appellant argues that “[t]here is no requirement that Appellant’s claimed invention produce unpredictable results” (Req. Reh’g 6), that “the Honorable Board has improperly shifted the burden of proof” (Req. Reh’g 5), and that a finding of predictable results “does not lead, *per se*, to a conclusion of obviousness” (Req. Reh’g 7). In the Opinion, we imposed no such requirement on Appellant. To the extent that the Opinion contained statements that Appellant construed as imposing such a requirement, we withdraw such statements. Rather, the issue raised and addressed was whether it would have been obvious to one of ordinary skill in the art to have combined the Gatz and Walker references. Given the weight of the evidence as enumerated – for example, the fact that Gatz and Walker both disclose known systems that perform the same function and would have performed predictable and expected functions (in this case, the same function) when combined – we agreed with the Examiner that it indeed would have been obvious to one of ordinary skill in the art to have combined the references.

Appellant also argues that the Decision relies on a new ground of rejection (Req. Reh'g 8). We disagree. Throughout the long history of “engagement with the question of obviousness, . . . cases have set forth an expansive and flexible approach” (*KSR*, 550 U.S. at 415) and courts have provided “instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art” (*KSR*, 550 U.S. at 415), particularly when the “combination of familiar elements according to known methods . . . does no more than yield predictable results” (*KSR*, 550 U.S. at 416). Whether applying this known standard in this case constitutes a new ground of rejection would depend on whether Appellant had a fair opportunity to react to the thrust of the rejection. *See In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976) (“the ultimate criterion of whether a rejection is considered ‘new’ in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection”).

In the present case, the Examiner rejected the disputed claims as being obvious over the combination of Gatz and Walker. We agreed with the Examiner’s assessment and affirmed the obviousness rejection over the combination of Gatz and Walker. In doing so, we provided amplified reasons in support of the affirmance, the amplified reasons being based on the known standards of obviousness as set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 and *KSR*, 550 U.S. (2007) (see above). Both the Examiner’s rejection and our analysis with amplified reasons for affirming the rejection are based squarely on the same evidentiary scheme – namely, the known standards of obviousness under 35 U.S.C. § 103(a).

Merely presenting amplified reasons in support of a previously applied rejection to the claims does not constitute a new ground of rejection. *In re Boon*, 439 F.2d 724, 727 (CCPA 1971) (holding that amplified reasons, even when relying “on additional facts, not previously in the record” do not constitute a new ground of rejection if “the ‘evidentiary scheme’ supporting the board’s position on this rejection does not differ in substance from that of the examiner”). As such, we disagree with Appellant’s contention that, in this case, our affirmation of the Examiner’s rejection on the same ground supposedly constitutes a new ground of rejection.

Appellant also argues that the Opinion overlooked a previously presented argument by Appellant that the combination of Gatz and Walker supposedly fails to disclose or suggest “the claimed ‘list of one or more applications that the first user is permitted to execute’” (Req Reh’g 12). We disagree with Appellant but we have nevertheless provided further clarification above regarding this issue (see above).

Appellant argues that “Appellant did not raise the issue of Gatz and Walker not being within the same field of endeavor” (Req. Reh’g 4). We agree with Appellant that Appellant did not raise the issue as to whether Gatz and Walker are in the same field of endeavor or not. Therefore, to the extent that the Opinion contains statements that solely address the issue of whether Gatz and Walker are in the same field of endeavor, we modify the Opinion to remove those statements.

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CONCLUSION

In view of the foregoing discussion, we incorporate our findings as outlined above but deny Appellant's Request for Rehearing with respect to making any change to our decision to affirm the Examiner's rejection of claims 1-11.

DENIED

rvb

CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP
STEVEN M. GREENBERG
950 PENINSULA CORPORATE CIRCLE
SUITE 2022
BOCA RATON, FL 33487